IN THE

Supreme Court of the United States

OCTOBER TERM, 1940.

No. .....

FOOD MACHINERY CORPORATION,

Petitioner,

vs.

FRUIT TREATING CORPORATION, WINTER PARK PACKING COMPANY, McDONALD CORPORATION, UMATILLA FRUIT COMPANY, and L. E. HOLLOWAY, TRADING AS L. E. HOLLOWAY & COMPANY,

Respondents.

BRIEF FOR PETITIONER.

Opinion:

The District Court filed no opinion. Its Findings of Fact and Conclusions of Law appear at R. 673 to 675. The opinion of the Circuit Court of Appeals is reported in 112 Fed. (2d) 119, and is reprinted at the end of the Transcript.

Jurisdiction:

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925. (43 Stat. 938; 28 USC 347).

Question Involved:

This is a patent suit involving only the usual defenses of want of invention, anticipation and non-infringement, all of which were determined in Petitioner's favor and a decree entered by the District Court sustaining the validity and infringement of the patent. No conflict of decision exists between the decision in this case and in any other Circuit Court of Appeals respecting the patentable novelty or scope of the instant Harvey invention. The Court of Appeals decided the case upon a defense raising an issue of fact not pleaded and not briefed or argued, *i.e.*,

> "When a patent is claimed for discovery, the law requires the patentee to state its component parts with clearness and precision, and to give a practical statement of its ingredients. When this burden is not met, or is met only vaguely and ambiguously, and it is apparent on the face of the specifications that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce the result desired, it is the duty of the court to declare the patent void. In this case, the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions. It is hardly conceivable that anyone, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments. Moreover, if from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. *Wood v. Underhill,* 5 How. 1, 12 L. Ed. 23.

"The patentee, obviously in an effort to make his claims and specifications so all-inclusive that any process for the dyeing of oranges that might be devised would necessarily infringe his patent, not only has made them too broad to be included in the scope of the monopoly given by the patent laws, but he has failed sufficiently to particularize a definite formula or process, complete with ingredients and the proportions of their mixture, which is essential to a valid patent. Since each of the three claims in question depends for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoilation of all, and the bill of complaint should have been dismissed.

The judgment of the district court is reversed, and the cause remanded for further proceedings not inconsistent with this opinion." (See Opinion Court of Appeals at end of printed record or p. 121 of 112 Fed.(2d).)

The use of the patented method is concentrated in the Fifth Circuit. Litigation elsewhere resulting in conflict of decision is improbable. Petitioner relies upon the rule of *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U.S. 47 at 50; *Mackay Radio & Telegraph Co. Inc. v. Radio Corp. of America*, 306 U.S. 86 at 89; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U.S. 464; *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477.

Argument:

Respondents' answer does not, as required under R.S.U.S. 4920 (35 USCA §69) plead or give notice of any defense that the Harvey Patent in suit does not describe the process or method in such full, clear, concise

and exact terms as to enable one skilled in the art to make and use the same. (R.S.U.S. 4888, 35 USCA §33.)

In *The Providence Rubber Co. v. Goodyear,* 76 U.S. 788, this Court laid down the rule that: "The proposition that the patent is fatally defective, because it is impossible to make merchantable goods according to the directions, cannot be entertained. The answer contains no averment on the subject. No such issue was tendered to the complainants, and they have had no notice that such a defense was intended to be relied upon." See further *Jennings v. Pierce,* Fed. Cas. 7283; *M. Swift & Sons v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391, 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 Fed. (2d) 503, 507, C.C.A. 8.

This Court has repeatedly held that the defense that the patent specification is not "in such full, clear, concise, and exact terms as to enable any one skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same" (R.S.U.S. 4886) is an issue of fact and to be determined upon the evidence. *Battin v. Taggert,* 17 How. (58 U.S.) 77; *Wood v. Underhill,* 5 How. 1, 46 U.S. 1; *Webster Loom Co. v. Higgins,* 105 U.S. 580; *Hogg v. Emerson,* 52 U.S. 587; *Corn Planter Patent,* 23 Wall. 181; *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Expanded Metal Co. v. Bradford,* 214 U.S. 366; *General Fireproofing Co. v. Expanded Metal Co.,* 212 U.S. 577; *Minerals Separation v. Hyde,* 242 U.S. 261, 270, 271; *Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65.

The grant of a patent is *prima facie* evidence of the sufficiency of the specification. It is a determination by

the Patent Office authorities of this fact and the *prima facie* validity of the patent prevails. The burden of proving otherwise is upon the defendant. *Chase v. Fillebrown,* 58 Fed. 374, 376.

The injection of this defense into the case by the Court of Appeals and its determination of the case thereon has foreclosed Petitioner from offering direct evidence of those skilled in the art as to the sufficiency of the specification. No proof was offered by the Respondents of any such insufficiency; no one skilled in the art testified that the specification was not so sufficient.

> "It is well settled that specifications of a patent are addressed to persons skilled in the art and a description sufficient to apprise them of the salient features of the invention is sufficiently definite. *Tilghman v. Proctor,* 102 U.S. 707, 26 L.Ed. 279; *Carnegie Steel Co. v. Cambria Iron Co.,* 185 U.S. 403, 22 S.Ct. 698, 46 L.Ed. 968."
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> *Karesh v. Shell-on Sol-Ted P. Co.,* 17 Fed. (2d) 496, 500;
>
> *cf. Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65.

The rule is that a specification is sufficient if a mechanic skilled in the art from the specification could use the invention. *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Minerals Separation v. Hyde,* 242 U.S. at 270-271; *Expanded Metal Co. v. Bradford,* 214 U.S. 366; *General Fireproof Co. v. Expanded Metal Co.,* 212 U.S. 577; *Corn Planter Patent,* 23 Wall. 181.

The Harvey Patent in suit covers the discovery of Dr. Rodney B. Harvey of the University of Minnesota of the well known Color Added Process, the use of which has greatly benefited the citrus producers of the States of Florida and Texas during the past five years. The patent does not purport to cover the broad idea of dyeing oranges or all processes of dyeing oranges. The patent was not so expanded or broadly interpreted by the District Court. The judgment of the District Court goes no farther than to sustain the patent to cover the particular process set forth in the patent at page 3, lines 13-63, R. 425.

The coloring of citrus fruit presents a problem which is unique in the dye industry. The peel or skin of an orange is composed of a combination of cellulose material and oil cells interlaid and coated with a natural wax. The natural color is accumulated just under the extremely thin waxy cuticle that is found on the exterior of the orange. A commercially successful process for enhancing the color of oranges must be one that will supplement the natural color by impregnating the skin or peel with additional dye to maintain the natural appearance of the fruit. A dye must be used which is approved by the Federal authorities as a non-poisonous food dye. Such dyes are soluble in oil but are not soluble in water. A formula must be provided which will permit a dye bath to be formed which can be readily applied to the fruit. The patent in suit describes more than one process by which this may be done.

The first of these processes is described at line 102, page 2 of the Harvey Patent [R. 424] and this process is not involved in this suit. This suit is limited to the question of validity of the Harvey Patent or the specific process or method described in the Harvey Patent, page 3,

lines 13-63, R. 425. The District Court found the patent valid as to this process and that this process was infringed by Respondents. [District Court's Findings of Fact and Conclusions, R. 673-675.] The dye bath of this process consists of from 90% to 99% of water. Since the dye will not dissolve in water, some additional substance is required to disperse the dye in the water. Soap is employed for this purpose. In addition to dispersing the dye the soap lowers the surface tension of the bath and acts to disintegrate the waxy coating of the fruit, thereby causing the dye to impregnate the peel or skin of the fruit. The soap dispersion of dye in the water is referred to in the patent in suit as an emulsion. This second process may for convenience be referred to as the aqueous soap process. A specific formula for this process is set forth in the patent (p. 3, lines 36-57) and reads as follows:—

> "Such emulsions may be prepared directly for use but preferably a stock emulsion is first made in concentrated form and then diluted with water. A suitable stock emulsion may contain from 50 to 250 parts of the color-imparting agents (solvent and coloring substances) and 25 to 250 parts of emulsifying agent and spreader such as soap, to 1000 parts of water by weight. Such stock emulsion in semi-liquid or paste form can then be diluted in the proportion of from about 1:50 to 1:200 with water or aqueous solution in the washing or treating tank. In other words, the final emulsion for imparting a desired color to fruit may contain from 0.5% to about 9.5% of solvent which carries a coloring substance and constitutes from about 0.01% to 1.0% by weight of the total and from about 90% to 99% of water, depending upon the quantity and character of the spreaders, emulsifying agents, and other materials present."

The judgment of the District Court was concerned solely with this second or aqueous soap process—"The process so commercially employed in the State of Florida is substantially the process disclosed in the patent in suit (page 3, lines 13-63) employing an aqueous dye bath containing soap and a colloidally suspended dye. Such process of enhancing the natural varietal color of fresh citrus fruit is not disclosed in any of the prior patents or printed publications relied upon by the defendants." [Finding No. 4, R. 673.] "There is no substantial difference between the accused process so employed by the defendants and the process described in the Letters Patent in suit (page 3, lines 13-63)". [Finding No. 13, R. 675.] The judgment was not concerned with the validity of the patent with respect to the first process in which no water or soap is present and only an oil or non-aqueous solvent is employed to carry the dye. This process is not in issue in this case.

There is no evidence in the record that any one skilled in the art was unable to successfully enhance the color of oranges by following the teachings and using the formula of the Harvey Patent, page 3, lines 13-63.

It is well settled law that in adjudicating the validity and infringement of a patent the Court need not go beyond the specific process in issue. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432; *Faultless Rubber Co. v. Star Rubber Co.*, 202 F. 927, 931; *Research Products Co. v. Tretolite Co.*, 106 Fed. (2d) 530, 534 C.C.A. 9.

As said by the Circuit Court of Appeals for the Second Circuit in *American Stainless Steel Co. v. Ludlum Steel Co.*, 290 F. 103 at 109:

> "Whether there may not be in Haynes an attempt to cover too much ground is a question that may be left until occasion for decision arises."

In its opinion in this case the Court of Appeals refers to "the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions.", and says: "It is hardly conceivable that any one, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments."

The patent is presumptively valid and sufficient. *Chase v. Fillebrown, supra.* The burden of proof is upon the Respondents. There is no evidence to sustain a Finding by the Court of Appeals that one skilled in the art would have any unusual difficulty in any of these particulars. For example, Respondents called as a witness Dr. James Otis Handy, a graduate in chemistry of Massachusetts Institute of Technology. [R. 255.] In testifying with respect to the dye art Dr. Handy testifies [R. 269]:

> "Q. Now again, this matter of temperatures. Why do you use temperatures in chemical reactions generally. Do they have any effect on the speed of the operation?
>
> A. They do. The raising of temperature, as far as I know, always increases the speed of reaction; on the other hand, there are certain low temperature reactions where you must keep things cool or you do not get the results you want; but generally you accelerate reactions by heat.
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> Q. Would you consider it within the skill of an ordinary mechanic to adjust the temperature of a solution to fit the material being treated in that solution?
>
> A. I do. I think it is a rather obvious method of investigation."

This testimony was given with reference to a prior art Hathorne Patent, Exhibit No. 15, but shows that those skilled in the art, contrary to the opinion of the Court of Appeals, would have no difficulty whatsoever with the temperature variations and would not require experimentation to the degree required to bring a given description under the rule of insufficiency upon which the Court of Appeals grounded its decision.

Respondents also called as a witness Dr. W. H. Beisler, head of the Department of Chemical Engineering at the University of Florida [R. 204] and asked him to "explain to the Court the disclosure of that patent" (the Harvey Patent in suit) [R. 205]. Dr. Beisler explains the two methods disclosed therein [R. 205-209] and testifies that he has made up an emulsion "according to the description of the second technique (method) in the Harvey patent" [R. 208-9]. That he has dyed oranges with such emulsion [R. 209]. It is significant that Dr. Beisler does not assert or refer to any ambiguity or insufficiency in the patent description, p. 3, lines 13-63, or to any necessity for experimenting. It is to be expected that the chemist will use the routine skill of his calling.

But the mere fact that one skilled in the art might be required to try the usual test experiments in order to determine exact proportions, temperatures, etc., is not sufficient to establish the legal objection of insufficiency of description. This is made clear by the decisions of this court in *Minerals Separation v. Hyde, supra,* 242 U.S. at

270-71; *Eibel Process Co. v. Minnesota & O. P. Co., supra,* 261 U.S. at 65; *Lawther v. Hamilton,* 124 U.S 1; *cf. Vortex Mfg. Co. v. Ply-Rite Cont. Co.,* 33 F. (2d) 302 at 308-9; *Wenborne-Karpen Dryer Co. v. Cutler Kiln Co.,* 285 F. at 75; *General Bakelite Co. v. General Ins. Co.,* 276 F. at 184; *Toledo Rex Spray Co. v. California Spray Chem. Co.,* 268 F. at 204, 205.

We respectfully submit that this case is one in which the discretionary power of this Court should be exercised by the writ of certiorari to the end that the case be decided in accordance with established principles of law.

Respectfully submitted,

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